

Trade Mark Examination Practise – Briefing note

As an office, we can only give information of a general nature in relation to trade marks and are precluded from giving advice in relation to specific trade mark applications. We cannot therefore, provide a pre-filing examination service.

There is no legal obligation to register a Trade Mark.

When filing an application, it is for the Applicant to specify the goods and/or services in relation to which, they wish to register their mark. An application may be filed online by [e-filing](#) or by completing the Application Form and posting it to the Patents Office.

When an application (which contains the minimum information required) is received, a filing date and an application number is assigned, and a filing receipt is issued.

The Minimum requirements for a filing date are:

- A request to register the Mark (completion of the prescribed application form meets this requirement),
- The name and address of the person requesting the registration,
- A representation of the mark (in respect of an e-filed application the representation should be submitted in Gif or Jpeg format),
- A statement or list of the goods and/or services for which registration of the mark is sought.

Anyone consulting the Register should be in a position to determine, precisely, the scope of protection afforded by such registration with regard to the goods and/or services listed. Therefore it is important that you specify the precise goods and/or services under each class in respect of which the mark is to be registered. It is not possible to add additional goods or services after the application has been filed. The only amendment permitted is to clarify the terms already included in the application.

In order to ensure that the goods and/or services are correct, please consult [TMclass](#) (TMclass brings together the classification databases of participating trade mark offices in order to facilitate the process of classifying your goods and/or services, and displays terms that are accepted by this Office). If there is a term you feel describes your goods and/or services and is not included in this database, you should include it in your application. If the office has a query or requires clarification, you will be given time to respond.

The application fee to register a Trade Mark is €70.00 *per class* of goods or services. If you wish to register a series of trade marks then there is an additional fee of €50.00 for each mark in excess of two in the series (Please note that a series may contain a maximum of 6 marks in a series).

For example, a series of 4 marks in 2 classes:

2 classes (of goods and/or services) x €70.00	= €140.00
Series of 4 marks (2 x €50.00)	= <u>€100.00</u>

Total €240.00

When an application is filed, the Application is examined to ensure that a Mark complies with the requirements of the Trade Marks Act, 1996, particularly in relation to Sections 8, 10 & 11* of the Act. (– See appendix 1)

As part of the examination process we carry out a search of the National and the Community Trade Mark Databases to see if there is a similar or identical trade mark registered or pending with an earlier filing date. If there is, we will cite the Mark and write to the Applicant, setting out their options and give time in which to respond.

Where an application is open to objection because the Mark is considered to be identical with or similar to an earlier trade mark and the goods or services for which registration is being sought are identical or similar to those for which the earlier trade mark is protected, the objection may be overcome if

- the application is amended to remove the conflicting goods and/or services, or,
- the consent of the proprietor of the cited mark(s) to the registration of the trade mark is obtained, or
- If evidence is provided to prove Honest Concurrent Use¹ of the trade mark for which registration is sought with the cited mark, in accordance with Section 12 of the Act, or
- if the registration of cited mark is surrendered or revoked.

When an application is accepted, it is then advertised in the next available copy of the Official Journal. The journal may be viewed online at patentsoffice.ie

Under the Trade Marks legislation, there is a three month window for the filing of observations or opposition to the registration of the Mark. If no opposition is received within the time allowed, then a request for the registration fee is issued (€177.00 - regardless of the number of classes).

On receipt of the fee, a Certificate of Registration is then issued. This protects the Mark in Ireland for a period of 10 years from the date of filing of the application. The registration can be renewed for further periods of 10 years at a time.

Only marks that are registered may use the ® symbol - the registered trade mark symbol in conjunction with their Mark.

Warning

You may receive unsolicited approaches from companies/entities offering registration services or requesting payment of fees in relation to your trade mark. The only office authorised to collect fees for the processing and administration of this trade mark is the Patents Office.

Anybody in receipt of such approaches or payment requests may contact the Irish Patent Office to confirm their authenticity.

¹ Evidence submitted should be in the form of a statutory declaration (a statutory declaration made in the State is required to be made before either a notary public, a commissioner for oaths, a peace commissioner or a practising solicitor).

Appendix 1

***Extracts from the Trade Marks Act 1996**

(Complete text may be accessed via the Patents Office website)

Absolute grounds for refusal of registration

8.—(1) The following shall not be registered as trade marks:

- (a) signs which do not satisfy the requirements of *section 6 (1)*;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of *paragraph (b), (c) or (d)* if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Trade marks.

6.—(1) *In this Act a "trade marks" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*

Relative grounds for refusal of registration.

- 10.—(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- (2) A trade mark shall not be registered if because—
- (a) it is identical with an earlier trade mark and would be registered for goods or services similar to those for which the earlier trade mark is protected, or
 - (b) it is similar to an earlier trade mark and would be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark.
- (3) A trade mark which—
- (a) is identical with or similar to an earlier trade mark, and
 - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,
- shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.
- (4) A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented—
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or
 - (b) by virtue of an earlier right, other than those referred to in subsections (1) to (3) and paragraph (a), in particular by virtue of the law of copyright, registered designs or any other law relating to a right to a name, a right of personal portrayal or an industrial property right.
- (5) Where by virtue of any such rule of law or earlier right as is referred to in subsection (4) a person would be entitled to prevent the use of a trade mark, that person is in this Act referred to as the proprietor of an "earlier right" in relation to the trade mark.
- (6) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Meaning of “earlier trade mark”.

11.—(1) In this Act an “earlier trade mark” means—

- (a) a registered trade mark, an international trade mark or a Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks;
 - (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark, even when the latter trade mark has been surrendered or allowed to lapse; or
 - (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.
- (2) References in this Act to an earlier trade mark include references to a trade mark in respect of which an application for registration has been made and which, subject to its being registered, would be an earlier trade mark by virtue of subsection (1) (a) or (b).
- (3) Where the registration of a trade mark specified in subsection (1) (a) or (b) expires, the trade mark shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the Controller is satisfied that there was no bona fide use of the trade mark during the two years immediately preceding the expiry.

* * * * *

Registered symbol ®

Section 94 of the Trade Marks Act, 1996 states:

Falsely representing trade mark as registered.

94. (1) It shall be an offence for a person—

- (a) falsely to represent that a mark is a registered trade mark, or
- (b) to make a false representation as to the goods or services for which a trade mark is registered, knowing or having reason to believe that the representation is false.

(2) For the purposes of this section, the use in the State in relation to a trade mark—

- (a) of the word "registered", or
 - (b) of any other word or symbol importing a reference (express or implied) to "registration",
- shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the State and that the trade mark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence under this section shall be liable on summary conviction to a fine not exceeding £1,000 and, in the case of a continuing offence, to a further fine not exceeding £100, for every day on which the offence continues.